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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,569	01/24/2002	Neil A. Roberts	013235-014	4049

7590 10/23/2003

Norman H. Stepno
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

HARDEE, JOHN R

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,569

Applicant(s)

ROBERTS, NEIL A.

Examiner

John R Hardee

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8, 10-14, 17-24, 26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) 5-8 and 19-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 10-14, 17, 18, 23, 24, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The final office action which was mailed on August 19, 2003 was issued before applicant's amendment of August 13, 2003 was received by the examiner. Accordingly, the final office action is WITHDRAWN. The examiner regrets any confusion that this may have caused.

DETAILED ACTION

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3, 10-14, 17, 18, 23, 24, 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The compositions as claimed can never contain, simultaneously, more than 35% of (a) or 64% of (b), if all of the ingredients are to total 100%. The only composition which can meet all of the conditions of claim 1 is one which consists of 35% of (a), 64% of (b) and 1% of (c). This does not appear to have been applicant's intention. Correction or explanation is required. The conditions of claim 2 cannot be realized, as (a) + (b) must add up to 94-98%, and this does not appear possible. Likewise, (a) + (b) in claim 13 must add up to 99%, which means that the recited amount of (c) can't simultaneously be present. Similar problems arise in the other dependent claims. Accordingly, they do not further modify the independent claims.

Double Patenting

4. Claims 1-3, 10-14, 17, 18, 23, 24, 26 and 27 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,428,720 B1. Reasons are of record in the previous office action.

Applicant's willingness to file a terminal disclaimer is noted.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-3, 11-14, 17, 18, 23, 24, 26 and 27 remain rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/03473. Reasons are of record in the previous office action.

Response to Arguments

7. Applicant's arguments filed August 5, 2003 have been fully considered but they are not persuasive. To the extent that the examiner can understand the claims as presently amended, the claims of US 6,428,720 B1 still read on them, and the double patenting rejection is maintained. Applicant has argued that the claims of the patent are drawn to species which are patentably distinct from those claimed presently. This is not persuasive because the patented claims recite the same materials, although they also recite 1,1,2,2-tetrafluoroethane.

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8. Applicant's amendment overcomes the rejection under 102(b).
9. Claim 10 does not appear to be obvious over the cited PCT reference, but it is indefinite and it does not further modify claim 1, to the best of the examiner's understanding. The 103 rejection over the rest of the claims is maintained. Applicant argues that the refrigerant art is crowded, and that one cannot simply vary the amounts of refrigerant constituents with any expectation of success. This is not persuasive because the reference teaches specific ranges in which one can expect success. These ranges were relied upon by the examiner in the formulation of the 103 rejection. If applicant believes that significant portions of the disclosed ranges are not operative, evidence should be submitted in the form of an affidavit. Attorney arguments cannot take the place of evidence.
10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (703) 305-5599. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (703) 308-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'J. Hardee', with a stylized, cursive script.

John R. Hardee
Primary Examiner
October 21, 2003